

Application No. 10/070863
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Amendment
Attorney Docket No. H01.2I-10436-US01

Amendments To The Drawings:

None.

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Remarks

This Amendment is in response to the Office Action dated September 29, 2004. In the Office Action, applicant was required under 35 U.S.C. § 121 to elect one of the three species disclosed in application 10/070,863 (hereinafter Wolter). In addition, claim 8 was rejected under 35 U.S.C. § 121 as being indefinite and claims 1 and 3-9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,342,055 (hereinafter Eisermann).

Applicant has elected one species (claims 1 and 3-9) and has withdrawn claim 2 without prejudice or disclaimer. Applicant reserves the right to prosecute the subject matter of claim 2 in an application claiming priority from Wolter. Applicant has also amended claims 1 and 3-9 which now establish antecedent basis, novelty, and present definite claims without prejudice or disclaimer to secure prompt issuance of the subject matter. Applicant has also added claim 10 to address alternative claim language in claim 7.

1. Election/Restrictions

The Office Action stated that Wolter contained three patentably distinct species, species 1 disclosed in FIG. 1, species 2 disclosed in FIG. 2, and species 3 disclosed in FIG. 3. Consonant with the requirements of 35 U.S.C. § 121, applicant identifies species 3 as the elected species which reads on claims 1 and 3-10. Applicant has withdrawn claim 2 which reads on a different species.

This election is a follow up to applicant's provisional election during a telephone conversation on September 21, 2004. During this conversation, attorney Richard Arrett provisionally elected to prosecute the invention illustrated in FIG. 3 without traverse. Applicant hereby affirms Mr. Arrett's provisional election with this written response.

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2. Claims Rejections 35 U.S.C. § 112

The Office Action stated that:

Claim 8 recites ... limitations ... previously recited in claim 1 resulting in double inclusion.
(Sections omitted)

Applicant has made numerous changes to claim 8 including establishing a clear antecedent basis, deleting reference numbers, and improving the grammar. These amendments are not made to change the scope of the claim but are made to place the claim language in the proper format for 35 U.S.C. § 112 purposes. Withdrawal of the rejection is respectfully requested. Applicant has also amended claims 1, 3-7, and 9 to avoid potential 35 U.S.C. § 112 problems.

3(a). Claims Rejections 35 U.S.C. § 102(e)

The Office Action stated that claims 1 and 3-9 are rejected under 5 U.S.C. § 102(e) as being anticipated by Eisermann. This rejection is based on a description of Eisermann which in the applicant's view, misconstrues the scope and details of what Eisermann discloses. For this reason as explained in detail below, this rejection is improper and Wolter is patentable over Eisermann. The component numbers in the following explanation correspond to those in Eisermann FIGs. 1-9.

3(b). Office Action Rationale

As explained in the Office Action, Eisermann discloses a polymer plate 12 into which a screw 14 or 16 is fastened by a titanium fastener part of the screw. Wolter discloses a plate into which a deformable element of the plate fixes a screw. The Office Action assumed that because titanium is harder than a polymer, if the screw 14 or 16 as described in Eisermann were to be further turned after it has been completely installed in the hole 30 in the plate 12, the titanium

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fastener would press the screw 14 or 16 against the polymer ridge of the hole 30 causing the ridge of the hole 30 to be deformed. The Office Action then concluded that this theoretical deformity would secure a screw in the same manner as claimed in Wolter.

3(c). Brief Summary of the Office Action's Mistake

It is impossible for the description in Eisermann combined with an excessively turned screw to meet the claimed invention in Wolter because the description in Eisermann makes it clear that once the screw 14 or 16 is completely installed in the hole 30 it cannot be turned any further. As a result, the specification in Eisermann makes it clear that it is impossible that the titanium fastener could ever deform the ridge of the hole 30 so it could not contemplate the deformed ridge described in Wolter.

3(d). Explanation of Why Eisermann Does Not Describe a Further-Turned Screw

Eisermann discloses that the shanks 38 or 42 of two the two kinds of screws 14 or 16 disclosed must pass through the hole 30 but that the head portions 40 or 44 of the screws 14 or 16 must remain in a spherical concave undercut 32 area of the plate 12. The disclosure explicitly states that the hole 30 is dimensioned so that once installed, the screw head portions 40 or 44 cannot move around the spherical concave undercut 32 or further enter the hole 30 (Eisermann column 6, lines 18 to 30). If the screw heads cannot move around or descend once installed, they cannot be further turned to deform the ridge of the hole 30.

3(e). Second Explanation of Why Eisermann Does Not Describe a Deformed Ridge

It is also impossible that Eisermann contemplates the screws 14 or 16 deforming the ridge of the hole 30 because when the screw is completely installed, the only portion of the screw in contact with the ridge of the hole 30 is the threadless shank 38 or 42. As a result, even if the structural impossibility of the screw head portion 40 or 44 passing the spherical concave

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undercut 32 were somehow overcome, a threadless shank 38 or 42 rotating about the ridge in the hole 30 would simply spin around and would never deform the ridge. Only screw threads could deform the ridge but when the screw 14 or 16 is installed the threads have already descended past the ridge of the hole 30 and into the bone.

3(f). Third Explanation of Why Eisermann Does Not Describe a Deformed Ridge

Lastly, Eisermann's specification also contains the limitation that the screw driving instrument 70 only presses a screw 14 or 16 into the plate 12 until the screw head 40 or 44 engages the spherical concave undercut 32 of the plate 12. This once again rules out the possibility of further turning the screw 14 or 16 to deform the hole 30 ridge (Eisermann column 7, lines 31 to 41).

3(g). 35 U.S.C. § 112(e) Conclusion

Eisermann does not disclose the bone fixation system of Wolter. Because the screw 14 or 16 cannot be further turned once it is completely installed and because the ridge only makes contact with a threadless shank, then regardless of what the screw 14 or 16 is made of, what the ridge in the hole 30 is made of, or how hard they are, the screws can never be further turned after having been completely installed and cannot deform the ridge in the hole 30 in the plate 12. Because Eisermann does not disclose a bone fixation system fixed with a deformable member, it does not meet the claim language in claims 1- 10 of Wolter. For these reasons, claims 1 and 3 - 10 in Wolter are patentable over Eisermann.

Withdrawal of the rejection is respectfully requested.

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Conclusion

For the reasons stated above, applicant believes claims 1 and 3-10 are allowable.

Applicant respectfully requests notification to that effect.

Respectfully submitted,

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